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triglycerides, . . .” (See, Paper No. 9, p. 2). The Examiner also contends that coconut oil, palm oil, rapeseed oil and soybean oil are disclosed for use as natural triglycerides and that wool is disclosed as a fiber to be lubricated. The Examiner argues that the claimed invention is obvious in light of the disclosure set forth in Becker '709. Applicants strenuously, but respectfully, traverse the Examiner's rejection and the arguments and contentions set forth in support thereof, for the following reasons.

It is well-settled that in order to establish a *prima facie* case of obviousness based upon a single reference, and thus shift the burden of proving non-obviousness onto Applicants, each of the following three criteria must be satisfied: **(1) the reference must contain a teaching or suggestion which would motivate one of ordinary skill in the art to modify the reference as suggested by the Examiner (it is not sufficient to say that the reference can be modified without a teaching in the cited reference to suggest the desirability of such a modification);** (2) there must be a reasonable expectation of success; and (3) the reference must teach or suggest each and every element of Applicant's claimed invention. (M.P.E.P. §2143).

To begin with, the rejected claims are directed to lubricant compositions comprising: a mixture of C₆₋₂₂ fatty acid methyl esters *consisting essentially of* esters derived from fatty acids selected from the group consisting of coconut fatty acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof; and emulsifiers. The compositions according to Applicants' claimed invention comprise methyl esters based on fatty acids which are vegetable oil-derived. Another embodiment of the claimed invention is directed to a process for lubricating wool *for combed wool sliver production*, the process comprising contacting wool fiber with a lubricant composition comprising a mixture of C₆₋₂₂ fatty acid methyl esters based on fatty acids selected from the group consisting of coconut fatty acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof.

Applicants have discovered that the use of C₆₋₂₂ fatty acid methyl esters, which are vegetable oil-derived, as lubricants for wool in combed sliver production results in unexpected advantages. Applicants' Specification describes in detail the differences between worsted yarn and woolen yarn, and the associated differences between combed sliver production and card spinning. (See, e.g., Applicants' Specification, pp. 1-3). As Applicants point out in

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their Specification, European Patent Publication No. EP 587601 B1, which is the European equivalent of Becker '709 (*see*, PCT Search Report from instant application's international stage submitted with the Information Disclosure Statement on September 18, 2001), discloses the use of fatty acid methyl esters as lubricants in the production of woolen yarns. (*See*, Applicants' Specification, p. 2, lines 30-32). As Applicants explain further, woolen yarn production and worsted yarn production (employing combed sliver production) have different demands on the lubricants used.

Becker '709 (*i.e.*, EP 587601) discloses fatty acid methyl esters based on C₈₋₂₂ fatty acids of various natural origins. Becker '709 provides no distinction between animal-based fatty acids and vegetable-based fatty acids. In fact, no distinction would be expected to be reported in Becker '709, because Applicants have discovered the advantage to using vegetable-based fatty acid methyl esters in preference to animal-based fatty acid esters when producing combed wool slivers. The fatty acid methyl esters of Becker '709 are disclosed as smoothing agents for use in lubricant compositions for card spinning. (*See*, Becker '709, col. 1, lines 51-53).

Becker '709 does not teach or suggest that the disclosed smoothing agents be limited to fatty acid esters based on vegetable oils. In fact, based upon the Examples set forth in Becker '709, it would appear that the reference actually teaches away from the exclusion of animal based fatty acids by specifically including tallow based materials. Moreover, Becker '709 makes no recognition of the advantage of vegetable-based fatty acid methyl esters in combed sliver production.

Accordingly, Applicants submit that Becker '709 does teach or suggest each and every element of the claimed invention. Specifically, Becker '709 fails to teach or suggest mixtures of C₆₋₂₂ fatty acid methyl esters *consisting essentially of* esters derived from fatty acids selected from the group consisting of coconut fatty acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof. Applicants also submit that Becker '709 contains no teaching or suggestion which would motivate one of ordinary skill in the art to modify the reference to limit the smoothing agents to vegetable oil based fatty acid methyl esters. Finally, one of ordinary

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skill in the art would find no expectation of success in such a modification, based upon the reference, when tallow is specifically included in the examples set forth therein.

Accordingly, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness, as none of the three criteria necessary to establish a *prima facie* case of obviousness has been satisfied. Thus, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a).

Finally, even if it were assumed for argument's sake that a *prima facie* case of obviousness could be established based upon the teachings of Becker '709, Applicants' showing of unexpected advantage sufficiently rebuts any such *prima facie* case. As shown in Applicants' Specification, the use of the inventive lubricant composition exhibits unexpected yield advantages in combed sliver production versus a conventional tallow-based fatty acid ester lubricant. (See, Applicants' Specification, p. 6, line 28, through p. 8). Applicants' specifically state that this advantage is surprising and unexpected. (See, *id.*, at page 3, lines 12-19). Thus, Applicants' submit that any alleged *prima facie* case of obviousness is sufficiently rebutted by the evidence contained in Applicants' Specification.

In view of the remarks set forth above, Applicants submit that all pending claims patentably distinguish over the prior art of record and known to Applicants, either alone or in combination. Accordingly, reconsideration, withdrawal of the rejection and a Notice of Allowance for all pending claims are respectfully requested.

Respectfully submitted,

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